

REMARKS

Pursuant to 37 C.F.R. §1.111, reconsideration of the instant application, as amended herewith, is respectfully requested. Entry of the amendment is requested.

Claims 1 and 3-7 are presently pending before the Office. Claim 2 has been canceled. Applicant has amended the claims. No new matter has been added. Support for the amendments can be found throughout the specification as originally filed. Applicant is not intending in any manner to narrow the scope of the originally filed claims.

The Examiner's Action mailed January 25, 2006 and the references cited therein have been carefully studied by Applicant and the undersigned counsel. The amendments appearing herein and these explanatory remarks are believed to be fully responsive to the Action. Accordingly, this important patent application is believed to be in condition for allowance.

Claims 1 and 6 were rejected under 35 USC 112, sixth paragraph. During the telephone interview with the examiner's primary examiner, it was determined that the claims were in proper format for invoking a means plus function clause and that this rejection was in error and would be obviated. Nevertheless, applicant has amended the affected claims and this issue is now rendered moot.

Relying on 35 U.S.C. §102(b), the Examiner has rejected the subject matter of claims 1 and 2 as being anticipated by Mauro et al., a patent for which applicant was the co-inventor. Applicant respectfully traverses the rejection and requests reconsideration.

Applicant respectfully submits that it is important to note that, historically, the Office and the Federal Circuit has required that for a §102 anticipation, a single reference must teach (i.e., identically describe) each and every element of the rejected claim. The Office has steadfastly and properly maintained that view.

The Mauro patent fails this test. The examiner clearly has misconstrued the structure of the Mauro patent. He alleges that the bracket strip that is attached to the steering column is a tray. During the interview with the examiner and the primary examiner on February 13, 2006, the examiner first stated that the front and rear wall portions were the air sides of the bracket, that is, no structure. When applicant noted the absurdity of such an allegation, the primary examiner noted that the thin edges of the bracket strip could be considered walls regardless of the fact that they did not extend upward to form a tray.

The cooler of Mauro is a special designed cooler that has an angular-shaped vertical interior portion that represents its underneath channel that saddles on the steering wheel column of the golf cart. The cooler bottom has a hook and loop fastener 72 that mates with a mating fastener 70 affixed to a flat metal strip 60 that has depending legs 64,62 that are bolted with the top half of a bracket assembly. The strip 60 is flat and significantly extends to each side beyond the overall width of the bracket assembly itself.

The examiner states that the cooler is insertable into the tray (bracket assembly) of Mauro. This is physically impossible with just a glance of the structure. A tray as contemplated by the present invention is a tray with contiguous upright walls around a bottom. The alleged tray of Mauro (the bracket assembly upper half) can not be considered a tray under ANY reasonable interpretation of its structure. It is not wide enough, the metal strip 60 prevents any insertion of any cooler, and it lacks four sides to form the tray or pan like device of the present

invention. Further, a view of Fig. 2 clearly shows the upper bracket assembly at one angle and the top metal strip pivoted about bolt 68 so that the cooler can rest on top of it.

During the interview, the primary examiner then alleged that Mauro's Cooler could be cut to leave just a bottom portion thereby forming a tray and that he would reject the claims on that basis regardless of any amendment to the claims submitted. First, the Mauro patent has absolutely no teaching by inference, implication or by expressly stating such an allegation of use that one could conclude that Mauro intended that his inventive cooler could be cut to form a tray to hold another cooler. This again is absurdity. As the co-inventor of the Mauro patent, applicant could not believe how anyone skilled in the art to reach this non-sensible conclusion about his own invention. In addition, another cooler could not be placed in a cut Mauro cooler because it would be impossible to maintain it in a level (horizontal) orientation due to the angular-shaped vertical interior portion that represents its underneath channel that saddles on the steering wheel column. The primary examiner then stated that someone could design two coolers to fit on either side the vertical portion. This again makes no sense as users would have to go out and design extremely small coolers for this limited use. The instant application uses a conventional cooler such as those made by the IGLOO company. Effectively, to require a specially designed cooler that may be too small to be practical, and to require a specially designed patented cooler to be cut to form a receiver tray for two other coolers will render the invention so impractical that it would lack any commercial value.

Regarding claim 2, the examiner alleges that the bracket assembly further includes flange portions 32 and 32 with a plurality of apertures 39 where fasteners are inserted. Applicants inventions has a plurality of apertures on each flange portion while the Mauro bracket has one aperture on each flange portion, NOT a plurality.

Accordingly, each and every element of Applicant's claims have not been taught in that single reference. In other words, the rejected claims do not read literally on any single item of prior art because Mauro simply does not teach, disclose or suggest the inventive tray of the present invention. Accordingly, Applicant respectfully submits that claim 1, as amended herein to include the limitations of claim 2, has not been anticipated by the Mauro patent under 35 U.S.C. §102(b), and respectfully requests that such rejection be withdrawn.

Relying on 35 U.S.C. §103(a), the Examiner has rejected the subject matter of the remainder of the claims as obvious over Mauro in view of Bookman (claim 3 and 4), over Mauro in view of Marinoni and Dickison (claim 5), over Mauro in view of Marinoni and Maguire (claim 6), and over Mauro in view of Blackman (claim 7). Applicant respectfully traverses the rejection and requests reconsideration.

It is evident that Applicant's invention is decidedly different from the teachings of the Mauro patent. Applicant herein incorporates by reference the above arguments regarding Mauro. By way of a few comments, the examiner states that Bookman teaches 2 elongated members 8 and 9, each having a plurality of spaced-part apertures in the flange portions (see Figure 1). Member 9 is not a flange portion that could be construed as a structure that could connect to the tray of the present invention. It is a plate with notches that is clamped to the steering column and the bracket assembly (which is nothing more than a hinge assembly) has brace member 13 with compression member 16 that connects to respective notches to maintain the smoking kit box in a horizontal orientation. If member 9 is considered a flange according to the examiner, then where are the apertures through which, fasteners could be inserted for fastening the tray directly to it as in the present invention? Further, the examiner states that members 8 and 9 each have aligned

with the spaced-apart apertures, fastener nut 20 recessed securement formed to the shape of the fastener nut to hold each fastener in place when tightening nut 20. In the present invention, the recessed part is depicted in Fig. 11 as 28. 20 in the Bookman patent is a rivet that compresses the riveted structure. A rivet head would rotate within the recessed area 2 of the present invention and the rivet pin would not allow the threading of a nut. Note: there is no nut in Bookman. Again, the interpretation of structure by the Examiner is non-sensible.

Accordingly, the Examiner has not established a prima facie case of obviousness.

Clearly, in the absence of any suggestion or any teaching whatsoever of how one skilled in the art would attempt to combine the Mauro patent with the other cited references to produce the present invention, one skilled in the art would certainly not find ample motivation to use the bracket of Mauro (or a cut version of the Mauro cooler) in combination with the features of the other cited references to arrive at the present invention.

The Office has used the claimed invention as a reference against itself as if it had preceded itself in time. Legal authority invalidates such an analytical or reverse engineering approach to patent examination. Nor would one of ordinary skill in the art have combined the cited references as alleged by the examiner, because nothing in the references themselves provides the impetus to combine their teachings. It is not Applicant's burden to refute the Office's position that it would have been obvious to one of ordinary skill in this art at the time this invention was made to arrive at the present invention in view of the cite references. It is the burden of the Office to show some teaching or suggestion in the reference to support this allegation. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d at 1051, 5 U.S.P.Q.2d at 1438-39 (Fed. Cir. 1988).

A finding by the Office that a claimed invention would have been obvious to one of ordinary skill in the art at the time the invention was made based merely upon finding similar elements in a prior art reference would be "contrary to statute and would defeat the congressional purpose in enacting Title 35." Panduit Corp. v. Dennison Mfg. Co., 1 U.S.P.Q.2d 1593 at 1605 (Fed. Cir. 1987).

Applicant respectfully submits that the Examiner's legal reasoning is flawed. The knowledge of those skilled in the art is derived from the prior art, not from the Examiner's mental impression of what those skilled in the art might or might not know. It is the law as evidenced in Graham v. John Deere that is controlling. As enunciated by the Graham court, §103(a) requires a comparison of the claimed invention with the teachings of the prior art. Otherwise, the PTO could simply say "I'm skilled in the art. That claim is obvious." The rules and the law require that the Examiner point out where in the prior art lies Applicant's claimed invention in the context of what those skilled in the art know. If it is not there, the public is not in possession of the invention, and, therefore, a rejection under 35 U.S.C. §103(a) will not lie.

There is no reasonable intrinsic or extrinsic justification for the proposed combination or modification. A prima facie case of obviousness has not been made.

Further, as the Federal Circuit observed in Orthopedic Equipment Co. v. United States, 702 F.2d 1005, 217 U.S.P.Q. 193 (Fed. Cir. 1983):

The question of nonobviousness is a simple one to ask, but difficult to answer . . . The difficulty which attaches to all honest attempts to answer this question can be attributed to the strong temptation to rely on hindsight while undertaking this evaluation. It is wrong to use the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims in suit. Monday morning quarterbacking is quite improper when resolving the question of nonobviousness.

In a recent case before the Circuit Court of Appeals for the Federal Circuit decided on May 13, 2002, the court found that a prior art reference will NOT be assumed to inherently contain claimed property because it discloses same structure. The plaintiff in the case was attempting to have the court declare defendant's patent invalid as obvious over a prior art patent that disclosed the same structure but did not specifically disclose a 2 percent limitation for reduction of a reflection contribution. Plaintiff argued that the limitation was inherently there because the basic structure was the same. Plaintiff had not shown that the prior art taught, suggested or motivated the reduction to about 2 percent. Crown Operations International Ltd. v. Solutia Inc., 62 USPQ2d 1917 (Fed. Cir. 2002).

In the instant application, the cited references are being in effect used by the examiner as disclosing its alleged inherent limitations or some cases non-existent limitations. Mauro deals solely with a patented cooler that attaches to a steering wheel using a bracket and pivoting top plate on which, the cooler is rested and secured with hook and loop fasteners, and from its disclosure, it is improper to inherently extend this reference to a tray designed to be mounted on the steering wheel as claimed by the present invention.

Nevertheless, in order to advance the case to allowance, Applicant has amended claims to increase their specificity of language. Claims 1 and 3-7 are patentable over the art of record. Accordingly, withdrawal of the rejection is respectfully requested.

NOTE: WHERE THE PRIMARY EXAMINER HAS ASSERTED DURING THE FEBRUARY 13, 2006 TELEPHONE INTERVIEW THAT REGARDLESS OF ANY AMENDMENT SUBMITTED HEREIN, HE WILL DIRECT THE REJECTION OF THE

CLAIMS AND ISSUE A NON-FINAL OFFICE ACTION, APPLICANT HEREIN RESERVES THE RIGHT TO REQUEST A TELEPHONE INTERVIEW WITH THE PRESENCE OF THE SUPERVISORY PATENT EXAMINER TO ENSURE THAT APPLICANT IS GIVEN A FAIR EXAMINATION OF THE MERITS OF THE CLAIMS. THE PRIMARY EXAMINER ASSURED APPLICANT THAT A NON-FINAL OFFICE ACTION WOULD BE ISSUED AND THAT A SUBSEQUENT TELEPHONE INTERVIEW WOULD BE GRANTED. SHOULD THE EXAMINER INSTEAD ISSUE A FINAL OFFICE ACTION CONTRARY TO THE AGREEMENT REACHED, THEN APPLICANT RESERVES THE RIGHT TO HAVE THE AGREED UPON INTERVIEW REGARDLESS OF THE STATUS OF THE PENDING APPLICATION.

APPLICANT FURTHER REQUESTS THAT WHERE HE CONSIDERS THIS APPLICATION TO BE VERY IMPORTANT TO HIM AND WHERE THE GOLFING COMMUNITY HAS ALSO RECOGNIZED IT AS A VALUABLE OPTION FOR ITS GOLF CARTS, THAT THE EXAMINERS NOT TREAT THE APPLICATION AS A "JOKE." APPLICANT WAS EXTREMELY UPSET AT THE PROJECTED ATTITUDES AND LACK OF PROFESSIONALISM OF THE EXAMINERS DURING THE INTERVIEW.

CONCLUSION

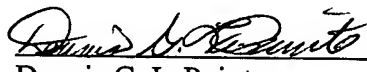
Even though the initial claims in this important patent application were drawn to a new, useful and nonobvious invention, they have now been amended to increase their specificity of language. Applicant respectfully submits that claims 1 and 3-7 are patentable over the art of record.

A Notice of Allowance is earnestly solicited.

If the Office is not fully persuaded as to the merits of Applicant's position, or if an Examiner's Amendment would place the pending claims in condition for allowance, a telephone call to the undersigned at (727) 943-9300 would be appreciated.

Very respectfully,

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